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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/940,360	08/27/2001	Jeff M. Anderson	10018309-1	5091

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

VU, TUAN A

ART UNIT	PAPER NUMBER
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2193

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/940,360

Applicant(s)

ANDERSON ET AL.

Examiner

Tuan A. Vu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to the Applicant's response filed 12/09/2005.

As indicated in Applicant's response, claims 1, 7, 13 have been amended. Claims 1-15 are pending in the office action.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-6, 7-10 and 13-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The Federal Circuit has recently applied the practical application test in determining whether the claimed subject matter is statutory under 35 U.S.C. § 101. The practical application test requires that a "useful, concrete, and tangible result" be accomplished. An "abstract idea" when practically applied is eligible for a patent. As a consequence, an invention, which is eligible for patenting under 35 U.S.C. § 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The test for practical application is thus to determine whether the claimed invention produces a "useful, concrete and tangible result".

Specifically, claim 1 recites a method comprising installing software for a device to be connected; and while doing so, suppressing an automatic installation mode upon the device being connected to the computer prior to software being completely installed by detecting and closing an auto-install mode window. First, the claim appears to not yielding any action because of the dependency on a device connection, termed otherwise as a reasonable absence of a useful result from a sole eventuality of a closing, which in itself is heavily based on a questionable device connection. Next, it appears that the claim's main step amounts to closing via executing computer instructions of a window prior to any software being fully installed. This action if actualized does not incur any useful consequence to the process as to accomplishing installation

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of software to the computer; hence the claim is perceived as an impractical idea for not fulfilling the Practical Application Test, because no concrete and useful result can be construed from the above recited steps as a whole. The claim thus is rejected for leading to a non-statutory subject matter.

Claims 2-6 are also rejected for not remedying to the absence of useful and concrete result deficiency of claim 1.

Claim 7 recites a computer medium having instructions to execute installation of software on a computer for a device to be connected; and while doing so, detecting a new window relating to an automatic installation mode, and causing it to close. As a whole, the installation process for a device that is yet to be connected amounts to detecting a particular window related to the installation of said device and closing it. It is hard for one skill in the art to perceive that by closing such a window any software related to the device has been installed by the claimed invention when the outset of the claim recites instruction to install software for a device. The claim amounts to a mere concept that fails the Practical Application Test because the claim fails to convey that a concrete and useful result has been achieved. The claim thus is rejected for leading to a non-statutory subject matter.

Claims 8-10 are rejected for not remedying to the lack of a concrete result as perceived in the base claim.

Claim 13 recites a device package comprising a device to be connected to a computer, means for suppressing an auto-install mode as recited in claim 1. The package claim appears to be a non-process claim including a device and some suppression means. From the specifications the context of suppressing as from Fig. 5 revolves around description of a computer executing a

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suppression based on some window detection (Specs: pg. 10-12). The claim as a whole is seen as a product/machine claim comprising a device used for the purpose to be coupled to a computer, and a computer executing on closing auto-install window. One prong of a USC 101 determination for statutory subject matter is a test is to determine whether the claim as a whole is reasonably yielding a concrete, useful and tangible result. As such, the combination of a device and computer for enabling a suppression of a window upon the device being inserted is only operative upon the connection of the device to the computer -- for any transformation to take place. This leaves the possibility that if the device is not connected, there will be no closing, hence no concrete result. The other possibility, in case there is connection and closing of the installation window, is whether or not some useful result can be perceived from the closing thus recited. If arguably, closing of the window is a concrete result, the mere fact of having a connectable device and a computer to close such window do no amount to useful result for one skill in the art when the onset describes a point of sale device. The claim fails to satisfy the Practical Application Test because of a reasonable absence of a useful result from a sole eventuality of a closing, which in itself is heavily based on a questionable device connection. Absent a very convincing possibility of a concrete and tangible result, the claim mostly does not exhibit any teaching leading to a useful result hence is rejected for leading to a non-statutory subject matter.

Claims 14-15 are also rejected for not remedying to the absence of useful and concrete result deficiency of claim 13.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the limitation recited as 'after instructing the user to connect the device ... computer' does not appear to have reasonable antecedent basis in the base claim. There is no recital of a computer instructing the user to connect a device in claim 1. This above lack of prior basis will be interpreted as an asynchronous or random event by which the connection of a device to the computer is being detected.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

7. Claims 1-5, 7-13, and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Fida International, "Prolink Hurricane 8000 ADSL Modem", *User's Manual*, VER. 1.5, 2000, pp. P1-P26 (hereinafter Fida).

As per claim 1, Fida discloses a method for installing software on a computer for a device to be connected to the computer and while installing the software, suppressing an automatic mode for the device initiated by an operating system of the computer upon the device being connected to the computer prior to the software being completely installed thereon, by computer instructions executed by a processor detecting and closing a window related to the

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automatic installation mode (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying window code that takes away a *CANCEL* button related to a verbose auto installation mode reads on computer executed instructions in the course of the detection of a autorun mode capability being the result of the device insertion).

As per claim 2, Fida discloses the user manually initiating (e.g. steps 1, 2, 3 – section 3.1.2 P10

As per claim 3, Fida discloses inserting of a media (e.g. step 2, section 3.1.1 or step 2, sec 3.1.2)

As per claim 4, Fida discloses detecting a window, whether it is related to installation, related to automated mode, and closing the window (e.g. *CANCEL* – section 3.1.1 pg. P7)

As per claim 5, Fida discloses initiation of installation mode (re claim 1); and also re-enumeration routine of the computer system (e.g. P14, P16 Note: inititating the re-enumeration process via Plug-and-Play and enumeration data displayed to user thereafter as a result of the execution of such initiating step amounts to initiating installation mode by inherently calling re-enumeration routines).

As per claim 7, Fida discloses a computer medium with computer instructions stored thereon for execution by a processor to perform a method comprising:

installing software for a device to be connected to a computer (e.g. section 3.1 p. P6);

and while installing the software, the instructions executed by the computer processor detecting a new window; such instructions determining whether it is related to automatic mode of installation; such instructions causing the window to close to exit the automatic installation mode faster than a user is capable of perceiving the window (e.g. *CANCEL* – section 3.1.1 pg. P7

-- Note: the underlying software that takes away a CANCEL button reads the instructions executed by the computer processor on closing faster than a user can perceive the window – refer to rationale of claim 1).

As per claims 8-10, the steps of associating variables or attribute to a button due to OS automatic detection of device within a window, such window having OS attributed handle, or some string identification imparted to such handle; and setting an countermanding action (a flag) upon the detection of such identification are all features inherent to Windows operating system and underlying process for identifying components and their handles; therefore the detecting of window with CANCEL button as disclosed by Fida disclose the attribute, string resources, a flag identifying a automatic mode of claims 8-10 (Note: all window or widgets in a Windows OS are created with attribute, ID, return type, and reference information to the parent widget or to superclass context/object)

As per claim 11, Fida discloses re-initiate the installation by detecting a CANCEL button (*CANCEL* – section 3.1.1 pg. P7) with its inherent window handle associating with a click on the CANCEL button; and also discloses a plug-and-play mode wherein automatic mode of installation keeps on proceeding (section 3.1.2), hence has disclosed appropriate action based on the window flag (plug-and-play flag versus automatic mode flag) as addressed in claim 10.

As per claim 12, refer to claim 5.

As per claim 13, Fida discloses a point of sale device package comprising: a device to be connected to a computer via a connector of the device coupling to a corresponding connector of the computer (sec 2.1 – pg. P4) and means for suppressing an automatic mode for the device initiated by an operating system of the computer upon the device being connected to the

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computer prior to the software being completely installed thereon, by computer instructions executed by a processor of the computer detecting and closing a window related to the automatic installation mode faster than a user is capable of perceiving the window (e.g. *CANCEL* – section 3.1.1 pg. P7 -- Note: the underlying window code that takes away a CANCEL button related to a verbose auto installation mode reads on computer executed instructions in the course of the detection of a autorun mode capability being the result of the device insertion).

As per claim 15, Fida discloses USB and IEEE-1394 (e.g. sec 2.1 – pg. P4 – Note: Modem and IEEE-1394 were inter-compatible technologies at the time the invention was made).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fida International, “ProLink Hurricane 8000 ADSL Modem”, *User’s Manual*, VER. 1.5, 2000, pp. P1-P26; in view of Polycom, “ViaVideo User’s Guide”, *ViaVideo QuickStart*, Nov. 2000, (hereinafter Polycom).

As per claim 6, Polycom, in a installation method of device being connected to a computer analogous to Fida wherein device driver or software components have to be installed first, discloses instructing the user to connect the device after the software has been installed (e.g. Installing Hardware - pg. 2). Although Fida does not explicitly teach waiting for the user to confirm on device connection, the connection of a device manually done during Fida’ interactive

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or verbose proceeding of a installation process is evident (see Fida: section 3.1.1 pg. P7); and it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide to the installation process by Fida so that there is a provision requesting the user to confirm on the device insertion after the initial step of installing the drivers is completed because the purpose is to prepare those drivers for the device to be properly installed/activated; and it is necessary that the user ensure that the device for which the driver is intended be connected for the installation to achieve such purpose; such that based on Polygon's using a GUI installation with interactive type buttons waiting for mouse-click events, this waiting for the user to confirm would have been obvious for the same grounds as set forth above.

As per claim 14, with regard to claim 13, Fida discloses a communication device (sec 2.1 – pg. P4 – Note: Modem being able to act as an signal processor for phone, PC, or a router is equivalent to a multi-function device); whereas Polygon discloses a camera (ViaVideo), both requiring USB port and installation of software first. It would have been obvious to combine the teachings of Fida and Polygon so that the device can also be a camera with the same benefits as taught from the rationale used in claim 1; because the more devices an invention can apply to the more marketable the product becomes.

Response to Arguments

8. Applicant's arguments filed 12/09/2005 have been fully considered but they are either moot in view of the new grounds of rejection or not persuasive. Following are the Examiner's observation in regard thereto.

(A) Applicants have submitted that Fida in view of Polycom does not disclose the suppression of an automatic installation mode by detecting and closing a window related to the

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automatic installation mode faster than a user is capable of perceiving the window (Appl. Rmrks, pg. 6, bottom, pg. 7, top) in view of the added limitations 'by computer instructions executed by a processor of the computer detecting and closing ... mode'. There is no particularly added weight that could be perceived from the amended part recited -- the computer detecting and closing of a window related to an autorun mode is execution of instructions by a processor --because of the very inherent action of a processor that detects a CANCEL window resulting from the detection of a potential autorun mode, detection which has been caused by a expansion card insertion event. The new rejection using solely Fida has addressed this limitation.

(B) Applicants have submitted that Fida teaches that a user has to click on a CANCEL button (Appl. Rmrks, pg. 7, middle) and it is the user, not the computer instructions executed by a processor, that does the detecting and closing. These arguments appear to fall under the assertion that by teaching of a click on a CANCEL button, Fida no longer fulfills the claimed limitation; that is, according to Applicant, this detection of a window and the closing thereof is done by the user manual intervention; and there would be no processor action in this window sequence as to finding of the CANCEL widget on the screen and deleting its instance by the underlying code of the Window main widget API. As mentioned above in section A, the added limitation that the instructions executed by the processor of the computer detecting and closing is interpreted as no more than an internal fawcet of the Window OS interfacing by a GUI screen with a user directing the installation mode. Thus, in light of the necessary intervention of computer code execution underneath the GUI façade, Fida has disclosed the detecting and closing by the computer processor executing the instructions. The claim does not establish

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specifics as to exactly which instructions are detecting and how they go about detecting or closing (or how they has been invoked, by which calling entities and from where) and as to what mechanics or timeframe underlying their action that would distinguish these instructions from the very instructions executed by the Window installation default system upon detection of a card insertion. The deficiency in putting forth the invention appears to be the relative broadness or lack of specificity (e.g. "instructions executed by the processor of the computer" – re claim 7 – can be interpreted as generic computer execution environment or specialized code from the readable media) in how the claim has been recited and as a result, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Hence, these arguments are not persuasive in light of the rationale as set forth in section A above.

(C) Applicants have submitted that the references relied by the Office Action teach user manuals; hence it would be antithetical in the fact that the user is needed when the instructions by the computer are doing the automatic suppressing. The claims do not lay out the specifics as to how this suppressing (of an automatic installation mode) amounts to; and the only specifics regarding how it is done would appear from the limitations recited as 'computer instructions executed by a processor of the computer detecting and closing' (Appl. Rmrks, pg. 8, top). Such computer instructions can be interpreted as the very instructions invoked with the event of the CANCEL button being clicked; because these very instructions are executed by the very processor that detects a possible autorun mode and as a result thereof, informs the user for performing a install mode selection; all of which execution falling under one computer executing

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code by one processor. That is, the claim cannot put forth what appears to be the inventive feature (as endeavored by Applicants) so that it fails to clearly read away from what Fido's sequence of computer actions has accomplished. The argument that it is the user who inherently performs detecting and closing of the window (Appl.. Rmrks, pg. 8, bottom) would be referred to the following observation. The insertion of a card in Fido is the triggering of a sequence of action, and one of which is the propping of a CANCEL button among others. Just this fact alone inherently teaches us that without the computer, the user would not be seeing any GUI option enabling the rest of the installation to follow through. In other words, the computer has detected from the media being inserted that an autorun exists, and because on that, the computer (along with its OS shell) effects appropriate internal calls to create the CANCEL widget. After the user has selected what to do, it is again the computer that follows up with executing the same contextual instructions that resume from where it has left off since the CANCEL button has been displayed; and via execution, these same instructions take the automode installation away along with the button. Again, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

For the above reasons, the claims stand rejected as set forth above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jeffrey Richter, "Microsoft Systems Journal: Q&A Win 32", September 1998, pp. 1-5; recites a means for enabling the computer itself without verbose interaction with the user to automatically skip the autorun as soon as a card insertion occurs.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan A Vu whose telephone number is (272) 272-3735. The examiner can normally be reached on 8AM-4:30PM/Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571)272-3719.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3735 (for non-official correspondence – please consult Examiner before using) or 571-273-8300 (for official correspondence) or redirected to customer service at 571-272-3609.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tuan A Vu
Patent Examiner,
Art Unit 2193
February 26, 2005